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EXAMINER

POLLACK, MELVIN H

| ART UNIT | PAPER NUMBER |
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2142

DATE MAILED: 01/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/667,723

Applicant(s)

YOSHIZAWA, HIROYUKI

Examiner

Melvin H Pollack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2000 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *see attached office action*.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 2, 4, 5, 7, 8, 10-13, 16, 19-24, 26, 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Dawson (6,252,588).
3. For claim 1, Dawson teaches an electronic apparatus (see abstract) comprising a transmitter transmitting an electronic mail (Fig. 4, #413 and col. 7, lines 34-35) in which a symbol including image information which enables a sender to be specified therefrom is included within signature information of the electronic mail (col. 7, lines 65-66).

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4. The examiner interprets from the specification that the applicant means the signature information as defined in the McGuinness article rather than the digital/electronic signatures as defined in the DSS standard.
5. As for claim 2, Dawson teaches that there is a generator generating the image information (col. 10, lines 43-44) by inputting an image of the sender (col. 16, lines 58-63).
6. As for claim 4, Dawson teaches that the image information includes an image related to at least a face of the sender (col. 16, line 59).
7. As for claim 5, Dawson teaches that there is an adding unit adding to the signature information a parameter which indicates an importance of the electronic mail (col. 2, lines 11-17).
8. As for claim 7, Dawson teaches that the parameter includes information which indicates a display priority order of the electronic mail (col. 2, lines 15-17).
9. As for claim 8, Dawson teaches that the parameter includes character, image, and/or audio information indicating a summary of the electronic mail (col. 8, lines 3-5 and col. 17, lines 40-46).
10. As for claim 10, Dawson teaches that the symbol includes information used for linking to the sender (col. 20, lines 51-61 and col. 27, lines 45-51).
11. Claim 11 is an electronic apparatus comprising the receiver of the message produced with the claim 1 apparatus, and the ability to display the image. Dawson teaches the reception of the message, and its display (Fig. 10). Further, the prior art shows that certain actions automatically anticipate complementary actions. For example, if a device transmits a message, it is anticipated

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that there must be a device that receives the message, and vice versa. Therefore, if claim 1 is rejected, then claim 11 must also be rejected for the reasons above.

12. Claims 12 and 13 are complementary receiving systems to the transmitting system drawn in claims 4 and 5, respectively. As shown before, it is anticipated to produce a reflected system. Therefore, if claims 4 and 5 are rejected, then claims 12 and 13 are also rejected for the reasons above. A similar rejection is made of claim 16, which also shares many of the same limitations as claim 13.

13. Claims 19 and 20 are complementary receiving systems to the transmitting system drawn in claims 8 and 10, respectively. As shown before, it is anticipated to produce a reflected system. Therefore, if claims 8 and 10 are rejected, then claims 19 and 20 are also rejected for the reasons above.

14. Claim 21 is drawn to many of the same limitations drawn in claims 11 and 13. If claims 11 and 13 are rejected, then claim 21 is also rejected for the reasons above.

15. Claim 22 is drawn to many of the same limitations drawn in claims 1 and 5. If claims 1 and 5 are rejected, then claim 22 is also rejected for the reasons above.

16. Claims 23 and 24 are drawn to a control apparatus for the electronic apparatus drawn in claims 1 and 11, respectively. Dawson teaches this as well (Fig. 1 and 18). Further, it is anticipated that the apparatus described above could not operate without some sort of mechanism that controls the transmitter to transmit certain content at certain times. Therefore, if claims 1 and 11 are rejected, then claims 23 and 24 are also rejected for the reasons above.

17. Claims 26 and 27 are drawn to a computer-readable storage medium which stores a program for causing a computer to implement the system drawn in claims 1 and 11, respectively.

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The prior art teaches that a hardware implementation is functionally equivalent to a software implementation. It is also anticipated that a program would be stored on a computer-readable medium. Therefore, if claims 1 and 11 are rejected, claims 26 and 27 are also rejected for the reasons above.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1-5, 7, 8, 10-13, 16, 19-24, 26, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dawson as applied to claims 1, 2, 4, 5, 7, 8, 10-13, 16, 19-24, 26, 27 above, and further in view of Lu et al. (5,432,864).

20. For claims 1, 2, 4, 5, 7, 8, 10-13, 16, 19-24, 26, 27, that which is anticipated is obvious.

21. As for claim 3, Dawson does not expressly disclose that the transmitter transmits the electronic mail only when an error between the image information generated by said generator and prestored image information is within a predetermined range. Dawson does disclose, however, a camera (col. 27, lines 55-60) and a database of pictures, as shown above. Lu teaches that a system is accessed when a person's face is compared with a stored image and approved (Fig. 3). Examiner notes that applicant's claims do not specify the method of storage, although more conventional storage is available (Fig. 7, #40). The purpose of Lu is a generic identity check device which can be used for a wide variety of causes (col. 1, lines 15-17). At the time the invention was made, one of ordinary skill in the art would have used the Lu authentication

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system in order for a user to access the mail account. The equipment and prior photos would already have been activated. In addition, it would make the system more user friendly, a motivation of Dawson (col. 7, lines 34-35) by removing the need to remember passwords, log-in names, and/or IP addresses.

22. Claims 1, 2, 4-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dawson as applied to claims 1, 2, 4, 5, 7, 8, 10-13, 16, 19-24, 26, 27 above, and further in view of the article on Web Page Embedding.

23. For claims 1, 2, 4, 5, 7, 8, 10-13, 16, 19-24, 26, 27, that which is anticipated is obvious.

24. As for claim 6, Dawson does not expressly disclose the parameter indicates the importance of the electronic mail by a display format of the signature information. However, Dawson and the other items have shown that the signature in this case is only a grouping of text, image, and audio information, ordered in a certain way. As such, it can be thought of as a small web page embedded in an email document. The embedding article teaches how to embed a web page in an email. But such a page can be embedded in the beginning, middle or end of the email text. Therefore, it can be used to place a signature-type file anywhere in the document, rather than simply attaching it to the end. At the time the invention was made, one of ordinary skill in the art would have added this functionality to Dawson for aesthetic purposes.

25. As for claim 9, Dawson does not expressly disclose that the information which indicates the display priority order of the electronic mail includes at least one of a display position and a display timing of the signature information. However, the display position information would have been included for the reasons above. The display timing embedding mechanism is shown

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in full detail in the Tripod article (Page 5, only picture). At the time the invention was made, one of ordinary skill in the art would have combined the teachings for the reasons above.

26. Claim 14 is a complementary receiving system to the transmitting system drawn in claims 5 and 6. As shown before, it is obvious to produce a reflected complementary system. Therefore, if claims 5 and 6 are rejected, then claim 14 is also rejected for the reasons above.

27. Claim 15 is a complementary receiving system to the transmitting system drawn in claim 7. As shown before, it is obvious to produce a reflected complementary system. Therefore, if claim 7 is rejected, then claim 15 is also rejected for the reasons above.

28. Claims 17 and 18 are a complementary receiving system to the transmitting system drawn in claims 9 and 7, respectively. As shown before, it is obvious to produce a reflected complementary system. Therefore, if claims 7 and 9 are rejected, then claims 17 and 18 are also rejected for the reasons above.

29. Claim 25 is drawn to a control apparatus for the electronic apparatus drawn in claim 14. Dawson teaches this as well (Fig. 1 and 18). Further, it is obvious that the apparatus described above could not operate without some sort of mechanism that controls the transmitter to transmit certain content at certain times. Therefore, if claim 14 is rejected, then claim 25 is also rejected for the reasons above.

30. Claim 28 is drawn to a computer-readable storage medium which stores a program for causing a computer to implement the system drawn in claim 14. The prior art teaches that a hardware implementation is functionally equivalent to a software implementation. Official notice is taken that a program would be stored on a computer-readable medium. Therefore, if claim 14 is rejected, claim 28 is also rejected for the reasons above.

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Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

32. Teachings on comparing pictures to prerecorded images: Glass et al. (6,332,193), Dohle et al. (5,251,265), Mowry, Jr., et al. (6,167,147).

33. Teachings for the processing and study of signatures: Hu et al. (6,360,010), Gibbs (6,356,935).

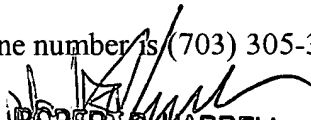
34. Teachings of combining an image with signature, identifying, or contact information: Grippi (5,103,486), Bjelkhagen (5,972,546), Uraki et al. (6,415,039), Yamaguchi (6,438,251), Coppersmith et al. (6,256,736), Barton (6,163,842).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H Pollack whose telephone number is (703) 305-4641.

The examiner can normally be reached on 8-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark H Rinehart can be reached on (703) 308-4815. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.


ROBERT B. HARRELL
PRIMARY EXAMINER

MHP
December 27, 2002